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09/294,760	04/19/1999	PAUL LAWRENCE HICKMAN	H&S1P002.A	6481

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Perkins Coie LLP
101 Jefferson Drive
Menlo Park, CA 94025-1114

EXAMINER
ELISCA, PIERRE E

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/294,760
Filing Date: April 19, 1999
Appellant(s): Hickman et al.

Paul L. Hickman
For Appellant

MAILED

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GROUP 3600

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed October 17, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

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a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of amendments After Final

No amendment after final has been filed.

(5) Summary of the Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 2, 8, 10-14 and 18-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192 (c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,935,954	Thompson et al.	6/1990
6,052,442	Cooper et al.	4/2000

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(10) Grounds of Rejection

The following ground (s) of rejection are applicable to the appealed claims:

Claims 1, 2, 8, 10, 11 and 18-20 are rejected under 35 U.S.C. 103 (a). This rejection is set forth in prior Office action, Paper No. 8

Claims 12-14 are rejected under 35 U.S.C. 103 (a). This rejection is set forth in prior Office action, Paper No. 8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8, 10, 11 and 18-20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Thompson et al.

As per claims 1, 18 and 19, Thompson substantially discloses an apparatus for automatically polling message service systems such that Applicant's monitoring of multiple accounts reads on figures 8 and 12 and column 12, lines 8-63, wherein a user may specify a polling routine.

Although Thompson et al do not specifically disclose polling plural e-mail accounts but rather a voice-mail account and an e-mail account, Thompson et al do not disclose that changes to

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their Administration routine, figure 12, can be made. More specifically, changes (see., column 12, lines 19-21) in the services to be polled are taught; e.g. a user could add different e-mail accounts to those services already being polled.

Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention for Thompson et al to poll as many e-mail accounts as desired as the system described in Thompson et al already polls at least a single e-mail account and the difference between one account and many is simply a matter of adding condition diamonds (as well as the corresponding program code) to figure 8 (i.e., element 808, 808a, 808b... each corresponding to a different e-mail account) and then transferring control to figure 9 for each additional e-mail account or condition diamond. This addition of condition diamonds is considered to be obvious to anyone who has computer programming ability.

Applicant's step of receiving a designation reads on a user possessing at least 2 computers/telephones (access protocols would be the computer/telephone number) at which to receive e-mail. See column 12, lines 47-55.

Regarding claim 8, Thompson discloses storing the mail data in a computer memory.

Regarding claims 10, 11 and 20, Thompson discloses Applicant's visually displaying reads on columns 12 and 13, lines 64-68 and lines 1-9, respectively.

Claims 12-14 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Thompson as applied to claim 1 above, and further in view of Cooper et al (U.S. Pat. No. 6,052,442).

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While Thompson et al taught in a PBX and LAN environment (e-mail is tied to a particular telephone), Cooper et al discloses a similar polling apparatus that operates in an internet (e-mail is tied to a particular e-mail address and/or service provider) environment, figure 3, element 74 and column 8, lines 6-12. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to expand the system of Thompson et al to include external WAN (service provider based) e-mail accounts as well as polling internal (PBX) telephone tied accounts as there will be a wider range of choices for communicating with a user.

(11) Response to Argument

With respect to Applicant's arguments that there is not a reason why a person would have more than one e-mail address in a PBX environment, the Examiner respectfully disagrees. It is conceivable and highly probable that, for example, a person operating a help desk would have a personal e-mail address/telephone for mail directed only to him as well as separate/different address/telephone at which to receive general help questions. Also, the idea behind Thompson et al is to retrieve and consolidate any messages received by a user via voice mail, fax or e-mail. As stated in the rejection, Thompson et al discloses that changes to their Administration routing, figure 12, can be made and, more specifically, changes (see., column 12, lines 19-21) in the services to be polled are possible. It is the Examiner's position that a user could add different e-mail accounts to those services already being polled. Therefore, it is the Examiner's belief that Applicant's proposed invention of consolidating a plurality of e-mail messages from

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various addresses/telephones to a user is taught by Thompson et al. Cooper et al was includes in the rejection mainly to show that polling of e-mail messages can be performed on a schedule in an internet (thus in a plural e-mail address/service provider) environment.

Furthermore, as was argued in this court case *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8, 11; 549 F.2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960). The court found that duplicate parts for multiple effects is not inventive concept over the prior art.

Applicant also maintains that Thompson and Cooper cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilli & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (references do

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not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter); and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Pierre E. Elisca

Primary Patent Examiner

January 28, 2004

Perkins Coie LLP

Customer No. 22,918

101 Jefferson Drive

Menlo Park, CA 94025

Need to type this in
Conferences
Jim Trimmell
John Hayes.